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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,384	10/26/2001	Scott J. Swartz	7840-82952-US	2791
7590	10/03/2006		EXAMINER	
JOHN R CASPERSON P O BOX 2174 FRIENDSWOOD, TX 77549				LASTRA, DANIEL
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/002,384	SWARTZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 May 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/31/2002.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-25 have been examined. Application 10/002,384 (METHOD FOR MARKETING DEMOGRAPHIC-DIRECTED PRINTED MEDIA) has a filing date 10/26/2001 and Claims Priority from Provisional Application 60296700 (06/07/2001).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over North (US 5,992,888) in view of Ditzig (US 4,717,021).

Claim 1, North teaches:

A method of targeting potential customers of a customer base with printed advertising media of a seller, method comprising the steps of

- a) identifying the customer base of a plurality of product establishments (see col 7, lines 17-30);
- b) determining customer demographic criteria corresponding to the customer base of each product establishment (see col 7, lines 5-20);
- c) determining seller demographic criteria corresponding to the seller's printed advertising media (see col 7, lines 5-30);
- d) calculating a desired advertising coverage area of the seller (see col 7, lines 17-30),

e) selecting the establishments in the desired coverage area whose customer base has customer demographic criteria that match the seller demographic criteria (see col 7, lines 15-42); and

f) providing each selected product establishment with the seller's printed advertising media, said printed advertising media adapted to attach to an enclosure of the product offered by the establishment so that the potential customers in the customer base are exposed to the seller's printed advertising media (see col 7, lines 15-42). North fails to teach that said product is a video product and that said product establishment is a product-rental establishment. However, Ditzing teaches a method of inserting advertisements into the enclosure of video products in order to identify, promote and/or advertise the movie, programs or other material recoded on the video product and also, to identify, promote, and/or advertise third party products and/or service. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that third party advertisers would identify a group of purchasers based upon said purchasers demographic information and would select a group of establishments that have interest of accessing this group of purchasers, as taught by North in order to display advertisements from said third party advertisers in the enclosures of video product-rental establishments, as taught by Ditzig in view that the customers that rent said video products would be exposed to said third party advertisements.

Claim 2, North fails to teach:

The method according to claim 1 wherein the seller's advertising media is color printed media. However, Official Notice is taken that it is old and well known in the promotion art to print color advertisements. It would have been obvious to a person of ordinary skill in the art that North would display color advertisements in the enclosure of products in order that said color advertisements would better attract the attention of customers.

**Claim 3, North fails to teach:**

The method according to claim 1 wherein the seller's advertising media is attached to a predetermined number of enclosures of the product and wherein a carrying fee is paid to the establishment. However, Official Notice is taken that it is old and well known in the promotion art to charge advertisers a carrying fee for inserting said advertisers' ads into vendors products in order to cover the expenses that said vendors would incur for said insertion. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that North businesses would charge a carrying fee to third party advertisers for inserting said advertisers' ads into the enclosure of products as it is old and well known to do so.

**Claim 4, North fails to teach:**

The method according to claim 3 wherein the seller pays an advertising fee that is greater than the carrying fee paid to the video product rental establishment. However, Official Notice is taken that it is old and well known in the promotion art that vendors charge advertisers an advertising fee that covers the displaying of said advertisers' ads into said vendors products. It would have been obvious to a person of ordinary skill in

the art at the time the application was made, to know that a vendor would not accept to display third party advertisements into said vendor's products if the cost of said displaying would be higher than the third party advertiser payment for said displaying.

Claim 5, North fails teach:

The method according to claim 3 where a difference between the advertising fee paid by the seller and the carrying fee paid to the establishment represents a profit. However, Official Notice is taken that it is old and well known in the promotion art that vendors charge advertisers an advertising fee that covers the displaying of said advertisers' ads into said vendors products. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a vendor would not accept to display third party advertisements into said vendor's products if the cost of said displaying would be higher than the third party advertiser payment for said displaying.

Claim 6, North fails to teach:

The method according to claim 1 wherein a first side of the enclosure of the video product receives a first seller's advertising media, and a second side of the enclosure of the video product receives a second seller's advertising media. However, Ditzig teaches a method of inserting different advertisements into the enclosure of a video product (see col 6, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that third party advertisers would identify a group of purchasers based upon said purchasers demographic information and would select a group of establishments that have interest of accessing this group of

purchasers, as taught by North in order to display advertisements from said third party advertisers in the enclosures of video product-rental establishments, as taught by Ditzig in view that the customers that rent said video products would be exposed to said third party advertisements.

**Claim 7, North fails to teach:**

The method according to claim 6 wherein the first and second seller's advertising media are directed to non-competing goods or services. However, Ditzig teaches a method of inserting different advertisements into the enclosure of a video product (see col 6, lines 35-50). Ditzig does not expressly teach that the first and second seller's advertising media are directed to non-competing goods or services. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the advertisements display into a video product would be directed to non-competing goods or service in order that the advertisers that are paying for inserting said advertisements into said enclosure would be ensured maximum exposure with minimum competition.

**Claim 8, North fails to teach:**

The method according to claim 1 wherein a first side and a second side of the enclosure of the video product receive the seller's advertising media. However, Ditzig teaches a method of inserting different advertisements into the enclosure of a video product (see col 6, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that third party advertisers would identify a group of purchasers based upon said purchasers

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demographic information and would select a group of establishments that have interest of accessing this group of purchasers, as taught by North in order to display advertisements from said third party advertisers in the enclosures of video product-rental establishments, as taught by Ditzig in view that the customers that rent said video products would be exposed to said third party advertisements.

Claim 9, North fails to teach:

The method according to claim 1 wherein at least one side of the enclosure of the video product receives the seller's advertising media. However, Ditzig teaches a method of inserting different advertisements into the enclosure of a video product (see col 6, lines 35-50). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that third party advertisers would identify a group of purchasers based upon said purchasers demographic information and would select a group of establishments that have interest of accessing this group of purchasers, as taught by North in order to display advertisements from said third party advertisers in the enclosures of video product-rental establishments, as taught by Ditzig in view that the customers that rent said video products would be exposed to said third party advertisements.

Claim 10, North teaches:

The method according to claim 1 wherein the advertising media is removeably affixed to a surface portion of the enclosure of the product (See North figure 3) but fails to teach that said product is a video product. However, the same argument made in claim 1 regarding this missing limitation is also made in claim 10.

**Claim 11, North teaches:**

The method according to claim 10 wherein the advertising media is removeably affixed to a portion of the enclosure with an adhesive material (see col 8, lines 33-37).

**Claim 12, North teaches:**

The method according to claim 10 wherein the advertising media is removeably affixed to a portion of the enclosure with pressure-sensitive material disposed between the advertising media and the surface portion of the enclosure (see figure 3).

**Claim 13, North teaches:**

The method according to claim 1 wherein the advertising media is contained within the enclosure of the product (see North figures 1 and 3) but fails to teach that said product is a video product. However, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 13.

**Claim 14, North fails to teach:**

The method according to claim 1 wherein the advertising media is contained within the enclosure of the video product, and the enclosure is translucent so that the advertising media is viewed through the enclosure. However, Ditzig teaches a method of inserting different advertisements into the enclosure of a video product (see col 6, lines 35-50) where said enclosure is substantially transparent so that the advertising media is viewed through the enclosure (see abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that third party advertisers would identify a group of purchasers based upon said purchasers demographic information and would select a group of establishments that

have interest of accessing this group of purchasers, as taught by North in order to display advertisements from said third party advertisers in the enclosures of video product-rental establishments, as taught by Ditzig in view that the customers that rent said video products would be exposed to said third party advertisements.

Claim 15, North fails to teach:

The method according to claim 1 wherein the advertising media is contained within the enclosure of the video product, and the enclosure is substantially transparent so that the advertising media is viewed through the enclosure. However, Ditzig teaches a method of inserting different advertisements into the enclosure of a video product (see col 6, lines 35-50) where said enclosure is substantially transparent so that the advertising media is viewed through the enclosure (see abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that third party advertisers would identify a group of purchasers based upon said purchasers demographic information and would select a group of establishments that have interest of accessing this group of purchasers, as taught by North in order to display advertisements from said third party advertisers in the enclosures of video product-rental establishments, as taught by Ditzig in view that the customers that rent said video products would be exposed to said third party advertisements.

Claim 16, North teaches:

The method according to claim 1 wherein the advertising media is retained against an inside portion of the enclosure of the product (see figure 3) but fails to teach

that said product is a video product. However, the same rejection applied to claim 1 regarding this missing limitation is applied to claim 16.

**Claim 17, North fails to teach:**

The method according to claim 1 wherein the video product is selected from the group consisting of a video tape, CD ROM, compact disc, DVD disc, laser disc and video game cartridges. However, Ditzig teaches a method of inserting different advertisements into the enclosure of a video product (see col 6, lines 35-50) where said video products comprises video tapes (see figure 1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that third party advertisers would identify a group of purchasers based upon said purchasers demographic information and would select a group of establishments that have interest of accessing this group of purchasers, as taught by North in order to display advertisements from said third party advertisers in the enclosures of video product-rental establishments, as taught by Ditzig in view that the customers that rent said video products would be exposed to said third party advertisements.

**Claim 18, North teaches:**

The method according to claim 1 wherein the customer demographic criteria is selected from the group consisting of age, income level, home ownership/rental status, race, marital status, religion, gender, national origin, ethnic makeup, number of children and age of children (see col 7, lines 5-15).

**Claim 19, North teaches:**

The method according to claim 1 wherein the seller demographic criteria is selected from the group consisting of age, income level, home ownership/rental status, race, marital status, religion, gender, national origin, ethnic makeup, number of children and age of children (see col 7, lines 5-25).

Claim 20, North teaches:

The method according to claim 1 wherein the seller demographic criteria is provided by the seller (see col 7, lines 5-25).

Claim 21, North teaches:

The method according to claim 1 wherein the step of determining the customer demographic criteria further includes the step of obtaining data from sources selected from the group consisting of census data records, municipal records, governmental records, public records, and marketing databases (see col 7, lines 7-15 "libraries of information").

Claim 22, North fails to teach:

The method according to claim 1 wherein the step of determining the customer demographic criteria further includes the step of obtaining customer demographic data by interviewing employees of the video product-rental establishment. However, Official Notice is taken that it is old and well known in the promotion art to interview vendors' employees in order to obtain customers' demographic information. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that North would identify the customers' demographic composition from the group

of purchasers that frequent an establishment by interviewing the employees of said establishment as it is old and well known to do so.

**Claim 23, North teaches:**

The method according to claim 1 further including the step of identifying a subject matter of the product and determining product demographic criteria corresponding to the subject matter (see col 9, lines 30-45) but fails to teach that said product is a video product. However, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 23.

**Claim 24, North fails to teach:**

The method according to claim 23 wherein the seller's printed advertising media is attached only to products having the product demographic criteria that match the seller demographic criteria (see col 9, lines 30-40) but fails to teach that said product is a video product. However, the same rejection applied to claim 1 regarding this missing limitation is also applied to claim 24.

**Claim 25, North teaches:**

A method of targeting potential customers of a customer base with printed advertising media of a seller, method comprising the steps of

identifying a customer base of a plurality of product establishments (see col 7, lines 5-25);

determining customer demographic criteria corresponding to the customer base of each establishment (see col 7, lines 5-25);

determining product demographic criteria corresponding to a subject matter of the product (see col 9, lines 25-40);

determining seller demographic criteria corresponding to the seller's printed advertising media (see col 7, lines 5-40);

calculating a desired advertising coverage area of the seller (see col 7, lines 15-30);

identifying the establishments in the desired coverage area having said customer demographic criteria that match the seller demographic criteria (see col 7, lines 15-25); and

providing each identified establishment with the seller's printed advertising media, said printed advertising media adapted to attach to an enclosure of the product offered by the establishment so that the potential customers in the geographical target zone are exposed to the seller's printed advertising media, wherein the seller's printed advertising media is attached only to products having the product demographic criteria that match the seller demographic criteria (see col 7, lines 5-25; col 9, lines 25-45).

North fails to teach that said product is a video product and that said product establishment is a product-rental establishment. However, Ditzing teaches a method of inserting display card into the enclosure of video products in order to identify, promote and/or advertise the movie, programs or other material recoded on the video product and also, to identify, promote, and/or advertise third party products and/or service. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that third party advertisers would identify a group of

purchasers based upon said purchasers demographic information and would select a group of establishments that have interest of accessing this group of purchasers, as taught by North in order to display advertisements from said third party advertisers in the enclosures of video product-rental establishments, as taught by Ditzig in view that the customers that rent said video products would be exposed to said third party advertisements.

***Conclusion***

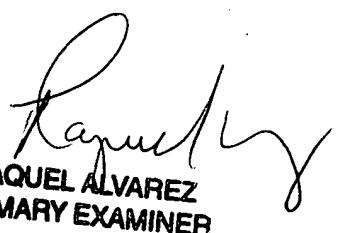
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
September 23, 2006

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER